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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,858	02/25/2000	MAIWENN BONNET	32143-152042	7234

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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/423,858

Applicant(s)

Bonnet et al

Examiner

Ralph Lewis

Art Unit

3732



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 28, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28, 32-35, and 37-40 is/are pending in the application.
- 4a) Of the above, claim(s) 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 28, 33, 34, and 38-40 is/are rejected.
- 7) ☒ Claim(s) 9-24, 32, 35, and 37 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3732

### **Informality in Referencing Claims**

The response of February 28, 2002 calls for the cancellation of claims 39-31 and 36. It is presumed that applicant does not desire the cancellation of claims 37, 38 and 39 added in the same response. It appears as though applicant desires the cancellation of claims 29-31 and 36 and the examiner has treated the application as if these claims have been canceled.

### **Response to Restriction Requirement**

In response to the restriction requirement of January 29, 2002 applicant elected Invention I directed to a preform, orthodontic apparatus and method of making with traverse. Applicant also rewrote claim 28 to fall within the elected invention. Accordingly, claims 1-24, 28, 32-35 and 37-40 all fall within the elected invention and are examined herein.

Applicant also argues that the "expansion core" of claims 25-26 and the "expansion mechanism" of claim 27 are only for use with the elected invention 1 and that the restriction is improper. The examiner notes, however, that claims 25 and 27 calling for an "expansion core" and "expansion mechanism" in their respective preambles set forth absolutely no structure for the claimed apparatuses, but rather a method with which they may be used. The claims call for no specific structure tying them to the method recited therein. Applicant reiterates in his response the method set forth in the specification, but points to no specifically claimed structure in the apparatus claims tying them to the selected invention of a preform, orthodontic apparatus and

Art Unit: 3732

method of making. Accordingly, claims 25-27 are withdrawn from consideration as being directed to nonelected inventions.

### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 28, line 7, there is no antecedent basis for "the fastening hook."

Claims 38-40 are all dependent on a canceled base claim 29.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3732

Claims 1-8, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Nilsson (4,391,861).

Nilsson discloses a hollow thermoplastic preform that is intended to be blow molded. The particular shape which applicant intends for the preform to be molded into fails to impose any objectively ascertainable structural distinctions from the device disclosed by Nilsson.

In response to the present rejection applicant argues that the preamble limitation that the claimed preform is “for obtaining a personalized orthopedic or dento-facial orthopedic apparatus” inherently requires limitations regarding size and biocompatible materials. The examiner agrees, and asserts that the Nilsson preform inherently meets such broad and undefined inherent limitations.

Applicant further asserts that the Nilsson preform if “exposed to the claimed expansion, it would tear as a result of the stretching required for the material to conform to the walls of the plaster model.” The examiner disagrees (Nilsson clearly provides for axial and transverse stretching -column 5, lines 40-46) with applicant’s assertion and notes that applicant offers no evidence to support this “tearing” position (i.e. declaration by expert in art, cited passage in reference, etc.). Moreover, it is noted that the present claims do not refer to any such “claimed expansion” as argued by applicant.

Applicant further argues that the presently rejected claims exclude a preform with a revolution axis and constant thickness (even though that is apparently what is shown in applicant’s Figure 1). The examiner sees no such limitation in the claims. If applicant wants that

Art Unit: 3732

limitation in the claims, then applicant should clearly put that limitation in the claims. The examiner, nor the public, are suited to guess what structural limitations applicant is intending to “inherently” read into the claims.

Claims 8, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art of a Bonnet’s Nighttime Lingual Envelope.

Applicant’s admits that Bonnet’s Nighttime Lingual Envelope is well known prior art having been developed after the publication of the examiner’s dentistry dictionary. Merely setting forth a new process to make an old and known prior art device fails to make the old prior art apparatus itself patentable.

Applicant argues that the prior art does not teach or suggest that the claimed preform could be used to form a Bonnet’s Nighttime Lingual Envelope. The examiner agrees and notes that the present claims are interpreted as being directed to the Bonnet’s Nighttime Lingual Envelope which is an admitted prior art device, not the preform. If the claims are only directed to a preform that is intended to be formed into a Bonnet’s Nighttime Lingual Envelope, then they are anticipated by the Nilsson preform as rejected above. The examiner is covering either interpretation of the claims.

Art Unit: 3732

**Allowable Subject Matter**

Claims 9-24, 32, 35 and 37 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend.


**Action Made Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. After-Final Fax (703) 872-9303.

R. Lewis  
May 20, 2002

  
Ralph A. Lewis  
Primary Examiner  
AU 3732